

## REMARKS

Claims 1-24 were previously pending in this application. Claim 1 has been amended. The amendment to claim 1 is supported at least by the disclosures in page 56, lines 6-15 and page 59, line 13 to page 60, line 2 of the specification. New claims 25-28 have been added. The support for these new claims can be found at least in page 60, line 24 to page 61, line 6; page 64, lines 12-17; and page 65, lines 13-24 of the specification. Claims 11, 12, 17, and 20 have been amended to correct typographical errors. These amendments are supported at least by the disclosures in page 125, lines 15-18 and page 126, lines 13-17 of the specification. No new matter has been introduced. Upon entry of the amendments, claims 1-28 will be pending.

### Claim Rejections Under 35 U.S.C. §103 over Onomichi in view of Ito

Claims 1, 2, 4, and 13 stand rejected under 35 U.S.C. §103(a) as allegedly being obvious over U.S. Patent Application Publication No. 2001/0005278 (“Onomichi”) in view of U.S. Patent No. 6,699,580 (“Ito”). Applicants respectfully traverse the rejections.

The Advisory Action dated December 18, 2008 indicates that the Request for Reconsideration filed November 21, 2008 did not place the application in condition for allowance and that the rejections of claims 1-24 were maintained.

The Advisory Action states in page 1, paragraph 11 that “Onomichi also teaches that the solvent can be organic and mixed with water up to 50%. See paragraph [0131].” Applicants point out that paragraph [0131] of Onomichi discloses a coating solution for the easy adhesion layer, not the infrared absorption layer (“the IR layer”). Contrary to the Examiner’s statement, the IR layer of Onomichi does not contain water. See paragraph [0183]; Table 1. As discussed in the Second Request for Reconsideration filed November 21, 2008, there would not have been any motivation or reasonable expectation of success to modify the IR layer of Onomichi, which uses a **hydrophobic organic solvent**, by adding a surfactant of Ito, which surfactant is soluble in water but has a low solubility in the **hydrophobic organic solvent**.

To advance prosecution, claim 1 has been amended to recite “the surfactant is localized on the surface of the near-infrared ray absorption layer.” The localization of a surfactant on the surface of the near-infrared ray absorption layer improves the durability of a near-infrared ray absorption layer and also provides slidability to the surface of a near-infrared ray absorption

layer. See specification at page 56, lines 6-15. Consequently, the handling properties becomes better (page 56, lines 14-15).

Neither Onomichi nor Ito teaches or suggests the localization of the surfactant on the surface of the near-infrared ray absorption layer, as recited in the currently amended claim 1. Therefore, a *prima facie* case of obviousness has not been established. Applicants respectfully request withdrawal of the rejections of claims 1, 2, 4, and 13 under 35 U.S.C. §103(a) over Onomichi in view of Ito.

**Claim Rejections of claims Under 35 U.S.C. §103 over Onomichi in view of Ito as applied to claim 1 and further in view of other references**

Claims 3 and 9 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Onomichi in view of Ito as applied to claim 1 and further in view of U.S. Patent Application Publication No. 2002/0127395<sup>1</sup> (“Kuwabara”). Claim 5 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Onomichi in view of Ito as applied to claim 1 and further in view of Japanese Patent Application 2004-202899 (“Sato”). Claims 6 and 7 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Onomichi in view of Ito as applied to claim 1 and further in view of U.S. Patent No. 6,703,138 (“Taki”). Claim 8 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Onomichi in view of Ito as applied to claim 1 and further in view of U.S. Patent Application Publication No. 2003/0186040 (“Oya”). Claims 10 and 24 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Onomichi in view of Ito as applied to claim 1 and further in view of U.S. Patent Application Publication No. 2003/0021935 (“Moriwaki”). Claims 11 and 12 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Onomichi in view of Ito as applied to claim 1 and further in view of Japanese Patent Application 2003-127310 (“Kumano”). Applicants traverse the rejections.

For the reasons stated above, claim 1 is not obvious over Onomichi in view of Ito. The deficiency of Onomichi in view of Ito is not cured by any of Kuwabara, Sato, Taki, Oya, Moriwake, Kumano, and combinations thereof because none of them teaches or suggests the

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<sup>1</sup> Applicants have noted that US 2002/375766, as recited on page 4 of the Final Office Action, does not exist. Instead, US 2002/0127395 fits the description of Kuwabara.

localization of the surfactant on the surface of the near-infrared ray absorption layer. In addition, none of them teaches or suggests one of ordinary skill in the art to modify the near-infrared absorption filter of Onomichi with the polysiloxane disclosed in Ito. Claims 3, 5-9, 10-12, and 24 would not have been obvious under 35 U.S.C. §103(a) over Onomichi in view of Ito, or further in view of Kuwabara, Sato, Taki, Oya, Moriwake, Kumano, and combinations thereof. Withdrawal of the rejections is respectfully requested.

**Claim Rejection Under 35 U.S.C. §103 over Onomichi in view of Ito as applied to claim 13 and further in view of other references**

Claim 14 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Onomichi in view of Ito as applied to claim 13 and further in view of U.S. Patent No. 6,770,430 (“Kubo”). Claims 15 and 16 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Onomichi in view of Ito as applied to claim 13 and further in view of U.S. Patent Application Publication No. 2004/0071883 (“Ogawa”). Applicants traverse the rejections.

For the reasons stated above, claim 13 (and all claims dependent therefrom) is not obvious over Onomichi in view of Ito. The deficiency of Onomichi in view of Ito is not cured by any of Kubo and Ogawa at least because none of them teaches or suggests one of ordinary skill in the art to modify the near-infrared absorption filter of Onomichi with the polysiloxane disclosed in Ito. Therefore, withdrawal of the rejections is respectfully requested.

**Claim Rejection Under 35 U.S.C. §103 over Onomichi in view of Ito and further in view of Kumano and other references**

Claim 17 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Onomichi in view of Ito and further in view of Kumano. Claim 18 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Onomichi in view of Ito and in view of Kumano as applied to claim 17 and further in view of U.S. Patent No. 4,948,635 (“Iwasaki”). Claim 19 has been rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Onomichi in view of Ito and in view of Kumano as applied to claim 17 and further in view of Ogawa. Applicants traverse the rejections.

For the reasons stated above, there would have been no motivation and no reasonable expectation of success to combine Onomichi and Ito to reach a process for preparing a near-infrared ray absorption roll using a coating solution containing, among other things, a near-infrared ray absorption dye and a surfactant, as recited in independent claim 17, and evidence of the importance of the HLB range of 2 to 12 and the concentration range of 0.01% to 2.0% by mass is disclosed in the specification. The deficiency of Onomichi in view of Ito is not cured by any of Kumano, Iwasaki, Ogawa, and combinations thereof at least because none of them suggests one of ordinary skill in the art to modify the near-infrared absorption filter of Onomichi with the polysiloxane disclosed in Ito.

Therefore, withdrawal of the rejections is respectfully requested.

**Claim Rejection Under 35 U.S.C. §103 over Onomichi in view of Ito and further in view of Iwasaki and other references**

Claims 20 and 21 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Onomichi in view of Ito and further in view of Iwasaki. Claim 22 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Onomichi in view of Ito and in view of Iwasaki as applied to claim 20 and further in view of Ogawa. Claim 23 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Onomichi in view of Ito and in view of Iwasaki as applied to claim 20 and further in view of Kubo. Applicants traverse the rejections.

For the reasons stated above, there would have been no motivation and no reasonable expectation of success to combine Onomichi and Ito to reach a process for preparing a near-infrared ray absorption roll using a coating solution containing, among other things, a near-infrared ray absorption dye and a surfactant, as recited in independent claim 20, and evidence of the importance of the HLB range of 2 to 12 and the concentration range of 0.01% to 2.0% by mass is disclosed in the specification. The deficiency of Onomichi in view of Ito is not cured by any of Kumano, Iwasaki, Ogawa, and combinations thereof at least because none of them suggests one of ordinary skill in the art to modify the near-infrared absorption filter of Onomichi with the polysiloxane disclosed in Ito.

Therefore, withdrawal of the rejections is respectfully requested.

### CONCLUSION

Applicants assert that all of the stated grounds of rejection have been properly traversed. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance.

In the event the filing of this paper is deemed not timely, Applicants petition for an appropriate extension of time. The petition fee, if needed, can be charged to Kenyon & Kenyon LLP's Deposit Account 11-0600. The Office is hereby authorized to charge any additional fees or credit any overpayments to Kenyon & Kenyon LLP's Deposit Account No. 11-0600.

The Examiner is invited to contact the undersigned at the telephone number below to discuss any matter concerning this application.

Respectfully submitted,

KENYON & KENYON LLP

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